

*WRK  
Docket  
4/13/03*

## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/199,805	07/19/2002	Ivo Franci Eggen	O 2001.662 US	2438

31846 7590 03/13/2003

INTERVET INC  
405 STATE STREET  
PO BOX 318  
MILLSBORO, DE 19966

EXAMINER

BAKER, MAURIE GARCIA

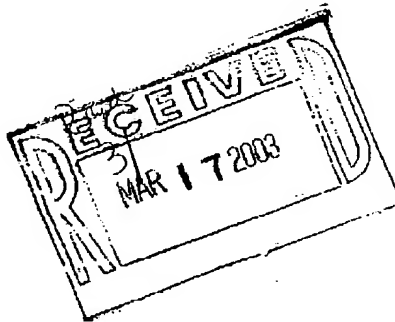
ART UNIT

PAPER NUMBER

1639

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



**Office Action Summary**

Application No.

10/199,805

Applicant(s)

Eggen et al

Examiner

Maurie G. Baker

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-55 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 28-55 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Serial Number: 10/199,805  
Art Unit: 1639

Page 2

### DETAILED ACTION

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1639 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

#### *Election/Restriction*

1. The Preliminary Amendment is noted. Claims 28-55 are pending. Restriction and election of species is required as set forth below. Note that to retain the Special status granted in Paper No. 4, applicant must elect without traverse.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 28-39, 41, 46-53 and 55 (all in part), drawn to a *first* process for rapid solution synthesis of a peptide using an amine scavenger where the scavenger is also used for deprotection, classified variously, for example, any of class 564, subclasses 305+ or 463+.
- II. Claims 28-39, 41-45, 48-53 and 55 (all in part), drawn to a *second* process for rapid solution synthesis of a peptide using an amine scavenger where the scavenger is not used for deprotection, classified variously, for example, any of class 564, subclasses 305+ or 463+.
- III. Claims 28-30, 40, 46, 47 and 49-53 (all in part), drawn to a *first* process for rapid solution synthesis of a peptide using a thiol scavenger where the scavenger is also used for deprotection, classified variously, for example, any of class 568, subclasses 61+.
- IV. Claims 28-30, 40, 42-45 and 49-53 (all in part), drawn to a *second* process for rapid solution synthesis of a peptide using a thiol

Serial Number: 10/199,805  
Art Unit: 1639

Page 3

scavenger where the scavenger is **not** used for deprotection,  
classified variously, for example, any of class 568, subclasses 61+.

V. Claim 54, drawn to a peptide or mixture of peptides, classified variously, for example, class 530, subclasses various.

3. The inventions are distinct, each from the other because of the following reasons:

4. Groups I – IV are different methods. Each of the methods is different because they use different steps, require different reagents and/or will produce different results. They therefore have different issues regarding patentability and enablement and represent patentably distinct subject matter. In the instant case, the methods of Groups I & III require that the scavenger is also used for deprotection, while Groups II & IV require that the scavenger is **not** used for deprotection. Thus, each of these methods has different steps. Groups I & II are different from Groups III & VI because the structure of the scavengers are different (amine vs. thiol). Thus, each of these methods uses different reagents.

5. Groups I – VI are related to Group V as process(es) of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the peptide(s) of Group V could be made by a different process than that of Groups I – VI. For example, the peptides could be made via biological methods (e.g. phage display). Moreover, applicant has set forth *four different*

Serial Number: 10/199,805  
Art Unit: 1639

Page 4

methods of making, which demonstrates that the peptides could be made by different methodology. Also note that the process by which the claimed peptide is made does not appear to lend patentable weight to the claimed invention.

6. Therefore, the groups that describe these inventions each have different issues regarding patentability and enablement, and represent patentably distinct subject matter, which merits separate and burdensome searches. Art anticipating or rendering obvious each of the above-identified groups respectively would not necessarily anticipate or render obvious another group, because they are drawn to different inventions that have different distinguishing features and/or characteristics. Each group could support a separate patent.

7. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. The different inventions would require different searches in the patent and non-patent databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

#### *Election of Species*

8. This application contains claims directed to patentably distinct species of the claimed invention for Groups I – VI. Election is required as follows.

Serial Number: 10/199,805  
Art Unit: 1639

Page 5

9. If applicant elects the invention of **Group I**, applicant is required to elect from the following patentably distinct species. Claims 28-30, 46, 47 and 49-53 are generic.

Species of amine scavenger

A *specific* amine scavenger should be elected, for purposes of search. Note that this election should result in a compound that is completely defined with all atoms and bonds shown (including the "temporary protecting" group, if present).

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

10. If applicant elects the invention of **Group II**, applicant is required to elect from the following patentably distinct species. Claims 28-30, 42-45 and 49-53 are generic.

Species of amine scavenger

A *specific* amine scavenger should be elected, for purposes of search. Note that this election should result in a compound that is completely defined with all atoms and bonds shown (including the "temporary protecting" group, if present).

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

11. If applicant elects the invention of **Group III**, applicant is required to elect from the following patentably distinct species. Claims 28-30, 46, 47 and 49-53 are generic.

Species of thiol scavenger

A *specific* thiol scavenger should be elected, for purposes of search. Note that this election should result in a compound that is completely defined with all atoms and bonds shown (including any "temporary protecting" group).

Serial Number: 10/199,805  
Art Unit: 1639

Page 6

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

12. If applicant elects the invention of **Group IV**, applicant is required to elect from the following patentably distinct species. Claims 28-30, 42-45 and 49-53 are generic.

Species of amine scavenger

A *specific* thiol scavenger should be elected, for purposes of search. Note that this election should result in a compound that is completely defined with all atoms and bonds shown (including any "temporary protecting" group).

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

13. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.
14. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and *a listing of all claims readable thereon*, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.



Serial Number: 10/199,805  
Art Unit: 1639

Page 7

15. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).
16. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.
17. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.
18. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

Serial Number: 10/199,800  
Art Unit: 1639

Page 8


remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

19. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:00 to 6:30 and alternate Fridays.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306- 3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.  
March 11, 2003



MAURIE GARCIA BAKER, Ph.D.  
PRIMARY EXAMINER